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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,811	08/10/2005	Andreas Fink	10191/3705	1654
26646 7590 06/08/2010 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER REESE, DAVID C				
ART UNIT		PAPER NUMBER		
3677				
MAIL DATE		DELIVERY MODE		
06/08/2010		PAPER		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/524,811
Filing Date: August 10, 2005
Appellant(s): FINK ET AL.

Gerard A. Messina
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/3/2010 appealing from the Office action mailed 11/24/2008.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

9-11, 13-17, and 19-26.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

(8) Evidence Relied Upon

6309132

Jacob et al.

10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

[1] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[2] Claims 9-11, 13-14, 17, 19, 22-23, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacob et al USP 6309132 because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, Jakob discloses of a fastening comprising:

a first component with a threaded bushing (housing 10 with threaded inserts 16,18, Column 2 lines 52-65)

a 2nd component (column 40) with a keyhole-like cut out with a smaller 50,52 and larger opening 46,48 (42,44, see Column 2 line 64-Column 3 line 6)

a self-locking (Column 3 lines 18-23, copied below) bolt (20) configured to be screwed into bushing such that it is guided with the head (38) through the larger opening (Fig 2) and head (38) engages behind the smaller cut out, said bolt having tool engagement surfaces (32) at an end of the shank (28), wherein the head (38) has a bottom surface (bottom of 38) connecting the head (38) to the shank and a top surface (top of 38) that is round and smooth (the bottom of 38 connects the head to the shank and the top of 38 is round and smooth).

Re claim 10: engagement surfaces are TORX® which is an external teething.

Re claim 11: Left hand thread is taught in Column 3 line 24-25.

Re claim 13: Self-locking bolt is taught in Column 3 lines 17-23 as a coated thread (60).

shank is partially provided with a plastic coating 60 which allows the fastener 20 to remain in the pre-assembled 20 position. The coating 60 not only secures the pre-assembled state, but also locks the screw when finally tightened as shown in FIG. 1.

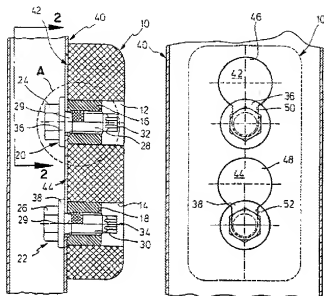


FIG. 1

FIG. 2

FIG. 1

FIG. 1

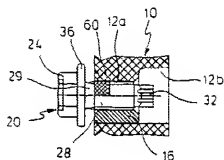


FIG. 3

Re claim 14: It has been held that all threads are to some extent thread-forming for a corresponding bore, and thus would be for a corresponding bushing. As noted above, the thread and its coating are self-locking.

Re claim 17: The fasteners are described as threaded shanks in Column 2:

Threaded fasteners 20, 22 are provided with a head 24, 26, threaded shanks 28, 30 and ends 32, 34. The threaded shank 28, 30 are threaded into the inner threads of the inserts 16, 18. The ends 32, 34 of the shanks 28, 30 each have a Torx-portion. The heads 24, 26 have integrally formed radial flanges 36, 38. A non-threaded portion 29 joins the heads 24, 26.

Re: Claim 19, 23, wherein the engagements surfaces (32) have a form of one of an external toothing or an external polyhedron, wherein the shank of the bolt has a left-hand thread (Column 3 line 24-25), and wherein the bolt has a coated thread (60, Column 3 lines 17-23), the self-locking being achieved via the coating.

Re: Claims 22, 26, wherein the bolt shank has a thread over at least a portion of the shank.

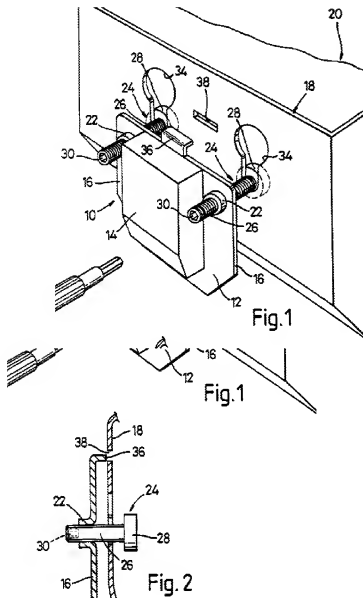
Claim Rejections - 35 USC § 103

[5] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[6] Claims 15-16 and 20-21, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakob et al USP 6309132 in view of EP 0747604. As noted above, examiner was unable to obtain a copy of the document, but she did obtain a copy of the figures, and thus is applying the reference as best she can, rather than give no opinion until the entire document is submitted.

EP 604 teaches a similar fastener to that of Jakob, but includes mating parts 36,38 which serve to prevent both rotation and translation of the 1st component when assembled. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Jakob and EP 604 before him at the time the invention was made, to modify Jakob as taught by EP604 to include translational and rotational guards to prevent translation of the 1st component and rotation of the 1st component in order to obtain a secure and stable assembly. One would have been motivated to make such a combination because if the components were allowed translational and/or rotational movement, the heads could move to the larger hole of the keyhole and the assembly would come loose.

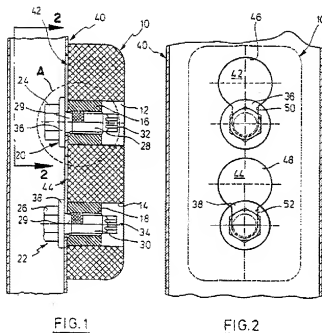


(10) Response to Argument

1.

First, with regard to the 102 rejection in view of Jacob et al., the applicant argues that Jacob et al., does not disclose of a fastener in which the head has a bottom surface connecting the head to the shank and a top surface that is round and smooth (see top of page 6 of appeal brief).

It is apparent that the applicant has misinterpreted the examiner's position by interpreting the top surface of the fastener as the hexagonal shaped portion (the top of 24). This, however, is not what the examiner has articulated in the instant rejection. Rather, the examiner in the instant case has interpreted the top surface of the head as the top of 38, not the top of 24. As reproduced below, it is apparent that the top of 38 as shown in both figs. 1 and 2 is indeed round and smooth. Moreover, there is nothing precluding the examiner from interpreting 38 as the head and the top of 38 as "a" top surface of the head. Rather, the head (38) has a bottom surface (bottom of 38) connecting the head (38) to the shank and a top surface (top of 38) that is round and smooth (the bottom of 38 connects the head to the shank and the top of 38 is round and smooth).



II.

Next, with regard to the 103 rejection, the applicant states that the examiner has failed to provide a proper prima facie case since the Office Action to date never made any findings, such

as, for example, regarding in any way whatsoever what a person having ordinary skill in the art would have been at the time the claimed subject matter of the present application was made (see page 8, fourth paragraph of applicant's appeal brief). This argument is unpersuasive. In response to this general allegation, it is pertinent to point out that the level of ordinary skill can be implicit in the record; the prior art itself reflecting such an appropriate level. Various holdings confirm this position: "We hold only that an invention may be held to have been either obvious (or nonobvious) without a specific finding of a particular level of skill or the reception of expert testimony on the level of skill where, as here, the prior art itself reflects an appropriate level and a need for such expert testimony has not been shown." *Chore-Time Equip., Inc. v. Cumberland Corp.*, 713 F.2d 774, 779 n.2 (Fed. Cir. 1983). "Although the Board did not make a specific finding on skill level, it did conclude that the level of ordinary skill in the art of asbestos removal and contamination control was best determined by appeal to the references of record" *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). "Judge Pfaelzer discussed various factors involved in determining ordinary skill in the art, but did not specify a particular level applicable here. Nor need she have done so, for the parties are in agreement that their respective chemical expert witnesses with extensive backgrounds in sulfur chemistry are persons of ordinary skill in the art." *Envyl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 697 (Fed. Cir. 1983). A recent non-precedential case also supports the position of the Office: "[I]t is well-established that in certain situations, such as with relatively simple and understandable technology, a specific finding on the level of ordinary skill in the art is unnecessary because the prior art itself is representative of the relevant level of ordinary skill." *Printguard, Inc. v. Anti-*

Marking Systems, Inc., 2008 WL 245415, at *11 (D. Mass. 2008) (citing *Chore-Time* at 779 & n.2).

Moreover, the Board of Patent Appeals and Interferences (Board) has also taken the position that the level of ordinary skill can be implicit in the record. *Ex parte Jud*, 85 USPQ2d 1280, 2006 WL 4080053 (Bd. Pat. App. & Interf. 2007). First, the Board explained that in general, evidence for the level of ordinary skill might be found in the applicant's disclosure, in the prior art references of record in the case, and in declarations or other testimony. *Id.* at 1282-83, 2006 WL 4080053 at *1. Commenting further about the role of the references, the Board stated:

Prior art references are cited precisely because they show what those skilled in the art would have known and been able to do before the effective filing date for the application. When used in combination, prior art references may even reveal a continuum of knowledge and ability greater than the sum of their separate, express disclosures.

Lastly, the Supreme Court in *KSR* has also reminded examiners that they may take into account "the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR* at ___, 82 USPQ2d at 1396. The Federal Circuit has confirmed that examiners should be "informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art." *In re Berg*, 320 F.3d 1310, 1315 (Fed. Cir. 2003).

Thus, since the prior art itself is representative of the relevant level of ordinary skill in the art, the examiner has indeed presented a proper prima facie case.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Victor Batson/
Supervisory Patent Examiner, Art Unit 3677

/DAVID REESE/
Examiner, Art Unit 3677

Conferees:

Victor Batson /vdb/

Heather Shackelford /hcs/